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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/718,974	11/22/2000	Richard E Rowe	IGT1P045/P-477	1552

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EXAMINER

NGUYEN, BINH AN DUC

ART UNIT	PAPER NUMBER
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3713

9

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/718,974

Applicant(s)

ROWE, RICHARD E

Examiner

Binh-An D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 41-58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 16-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4-6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-15 and 41-54, drawn to a smart card for providing game services and method for executing game play with the aid of smart card, classified in class 463, subclass 43.
 - II. Claims 16-26 and 27-40, drawn to gaming machine and method for executing a game play on the gaming with the aid of smart card, classified in class 463, subclass 25.
 - III. Claims 55-57, drawn to gaming machine and method for executing a game play on the gaming machine with the aid of a personal digital assistant, classified in class 463, subclass 39.
 - IV. Claim 58, drawn to a method for executing a game play on a gaming machine with the aid of a personal digital assistant, classified in class 707, subclass 10.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP §

806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the gaming machine can be played without the smart card. The subcombination has separate utility such as a processor and memory to execute gaming applications.

4. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions, or different effects such as storing game applications and playing game utilizing aid from a PDA.

5. Inventions I and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions, or different effects such as the PDA itself can be used to play a game.

6. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different

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functions, or different effects such as the gaming machine can be operated without the aid of smart card.

7. Inventions II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation, different functions, or different effects such as the gaming machine can be operated without the aid of a PDA.

8. Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention IV has separate utility such as it can be used independently as a gaming machine. See MPEP § 806.05(d).

9. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

10. Because these inventions are distinct for the reasons given above and the search required for any Group not required for any other Group, restriction for examination purposes as indicated is proper.

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11. This application contains claims directed to the following patentably distinct species of the claimed invention:

12. **In Group I:**

Species 1a: claim 2.

Species 1b: claim 3.

Species 1c: claim 4.

Species 1d: claim 5.

If Group I is elected, applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently in Group I, claims 1, 6-15, and 41-54 are generic.

13. **In Group II:**

Species 2a: claim 19.

Species 2b: claim 25.

If Group II is elected, applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently in Group II, claims 16-18, 20-24, and 26-40 are generic.

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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

14. During a telephone conversation with applicant's representative, Mr. David Olynick on July 9, 2003, besides providing a faxed Declaration and Power of Attorney, as requested by the Examiner, a provisional election was made without traverse to prosecute the invention of Group II, claims 16-40. Mr. Olynick further elected Species 2a, claim 19 and requested Species 2c, claim 25, to be included in the examination of

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the merit; this request has been accepted by the Examiner. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-15 and 41-58 are hereby withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

15. Claims 16- 40 are objected to because of the following informalities:

In claims 16 and 27, the recited word "resident" (line 5 of claim 16, and line 10 of claim 27) should be changed to "residing".

In claim 23, the term "further comprising:" should be inserted before "a graphical display."

Appropriate correction is required.

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 23 and 27-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 23 is vague and indefinite since its scope is unclear. Note, the applicant should insert the term "further comprising" before "a graphical display."

In claim 27, the limitation of "receiving gaming instruction from one or more gaming applications" renders the claim vague and indefinite. It is unclear exactly how many gaming applications are being executed. Note that, applicant should replace the

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recited phrase "from one or more gaming applications" by inserting "from at least one of a plurality of gaming applications."

In claim 32, the recited phrase "one or more of" (lines 1-2) is vague and indefinite since it is unclear exactly how many or what types of gaming instructions are referred. Note, the recited term "one or more of" should be replaced by "at least one of".

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

19. The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the

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application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

20. Claims 16-18, 20, 21, 23, 26-29, and 31-40 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over LeMay et al. (6,439,996).

LeMay et al. teaches a system and method for executing a game play (controlling the presentations of games) with the aid of a smart card (key 10), comprising: a gaming machine (30) having a master gaming controller configured to present a game on the gaming machine using gaming instructions generated by a processor on the smart card and gaming instructions residing on the master gaming controller (Figure 1); and a smart card reader (12a, Figure 1) providing a communication interface between said smart card and said master gaming controller (4:8-24); gaming machine further comprising a network communication interface wherein the smart card (key 10) communicates with a game service server using said network communication interface (3:33-45 and 4:1-7); the game instructions generated by a processor on the smart card specified a pay-table used by the gaming machine in the game presentation (2:1-9); gaming machine further comprising a graphical display (33); receiving a signal

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indicating a smart card has been inserted in a smart card reader on the gaming machine; establishing communications with the smart card; receiving gaming instructions from at least one of a plurality of gaming applications executed by a processor on the smart card; and presenting a game play on the gaming machine using the gaming instructions from the smart card and using gaming instructions generated by a master gaming controller residing on the gaming machine; authenticating the smart card (4:8-19); receiving a list of gaming applications available on the smart card from the smart card (changing game or downloading to media from external source; 3:9-22); the gaming instructions include pay-tables, or a game play history (3:9-46); communicating with a remote game server (3:23-46); sending game play information to the smart card (3:33-46); downloading a gaming application (or game) stored on the smart card (key 10) and executing said gaming application on the gaming machine (2:1-9); and game configuration information is selected from the group consisting of a game type, a game version, a game background, a game denomination and a game wager amount (changing games of the machine, 2:1-9 and 3:14-22). LeMay et al. does not explicitly teach the limitations of: game service server is selected from the group consisting of an account server, a bonus game server, a progressive server, a player tracking server and a cashless system server (claim 18); gaming machine comprising a speaker (for outputting audio components) (claim 21); the game is selected from the group consisting of a video black jack game, a mechanical slot game, a video poker game, a video keno game, a video pachinko game and a video card game (claim 26); sending gaming machine identification information to the smart card (claim 31); and

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game component includes at least one of a graphical game component and an audio game component (claim 33) (gaming applications containing graphics and sounds for generating video and audio of the game); game play information is for a group of gaming applications consisting a video black jack game, a video slot game, a mechanical slot game, a video poker game, a video keno game, a video pachinko game and a video card game (claim 37); wherein the game is a pull tab game (claim 40). These limitations, however, are considered inherent to standard gaming machines such as used in LeMay et al.; alternatively, it would have been obvious to include such known features to LeMay et al.'s gaming machine in order to provide a player with standard known conveniences.

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 16-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Montgomery (6,564,995) in view of Acres et al. (5,752,882).

Montgomery teaches a terminal (82) for executing a game play with the aid of a smart card (20), comprising: a terminal (82) using (a) gaming instructions generated by a processor on the smart card and (b) gaming instructions resided on the master controller (micro-controller 86); and a smart card reader providing a communication

interface between said smart card and a master controller (micro-controller 86)(Figures 2, 7, and 8); receiving a signal indicating a smart card has been inserted in a smart card reader on the terminal; establishing communications with the smart card; receiving gaming instructions from at least one of a plurality of applications executed by a processor on the smart card; and presenting an application on the terminal using the applications from the smart card and using applications generated by a master controller (micro-controller 86) residing on the terminal; authenticating the smart card; receiving a list of applications available on the smart card from the smart card; selecting a application from the list of applications and requesting the smart card to execute the selected application (Figure 5B); application configuration information consisting of a application type; sending application information to the smart card; downloading an application stored on the smart card and executing said application on the terminal (6:6-7:46); downloading applications stored on the smart card and executing said application on the terminal. See also, Figures 1-8 and columns 1-7.

Montgomery does not explicitly teach the limitations of: a gaming machine having master game controller; game instructions specified a progressive game (claim 19), a pay-table (claim 20), and a bonus game (claim 25); the speaker outputs audio components stored in a memory on the smart card (claim 22); the graphical display outputs graphical components stored in a memory on the smart card (game applications) (claim 24); the gaming instructions include game configuration information (claim 32); game component includes at least one of a graphical game component and an audio game component (claim 33); in response to the gaming instruction received

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from the smart card, communicating with a remote game server (claim 35). Acres et al., however, teaches a gaming machine for executing a game play with the aid of smart a card (120), comprising a master game controller; game instructions specified a progressive game, a pay-table, and a bonus game; the gaming instructions include game configuration information; game component includes at least one of a graphical game component and an audio game component; in response to the gaming instruction received from the smart card, communicating with a remote game server. See Figures 1-8 and 20-34; and columns 1-3, 6-9, 12-20, and 23-37.

Note that, the limitations of gaming machine further comprising a network communication interface wherein the smart card communicates with a game service server using said network communication interface (claim 17); a graphical display (claim 23); the game service server is selected from the group consisting of an account server, a bonus game server, a progressive server, a player tracking server and a cashless system server (claim 18); gaming machine comprising a speaker (claim 21); game play information is for a group of gaming applications consisting a video black jack game, a video slot game, a mechanical slot game, a video poker game, a video keno game, a video pachinko game and a video card game (claims 26 and 37); sending gaming machine identification information to the smart card (claim 31); and the game is a pull tab game (claim 40) are inherently known from standard gaming machines such as used in Acres et al. .

Further, note that, by utilizing gaming applications from Montgomery's smart cart on the gaming system of Acres et al., the speaker and video display of the gaming

system would certainly outputs audio/video components from the smart card (as the games being executed by the game machine).

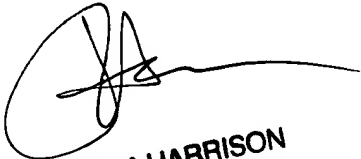
Thus, it would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Montgomery's with a progressive bonus gaming system utilizing smart card, as taught by Acres et al., as an enhancement to gaming features, i.e., providing state of the art features to players, that would attract them to games and thus be profitable.

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh-An D. Nguyen whose telephone number is 703-305-5713. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

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JESSICA HARRISON
PRIMARY EXAMINER